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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,512	02/23/2004	Jorg Senn-Bilfinger	P65775US2	7600
136	7590	11/04/2005	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			RAHMANI, NILOOFAR	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,512

Applicant(s)

SENN-BILFINGER, JORG

Examiner

Niloofer Rahmani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-68 are pending.
2. A certified translation of foreign priority papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Therefore, the benefit of priority date cannot be granted.
3. ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-67 are rejected under 103(a) as being unpatentable over Senn-Bilfinger et al. WO 98/42707.

Determination of the scope and content of the prior art (MPEP §2141.01)

Senn-Bilfinger et al. WO 98/42707 disclosed compounds on table 1, page 6, which have the same structural core as the instant claims.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claims and the prior art compounds is that the instant claims have two of R2a, R2b, R3a, R3b being hydrogen, with the remaining two selected from hydroxyl, methoxy, propoxy, isopropoxy, and methoxy-propoxy, while the prior art disclosed generically R4a-R5b which corresponded to R2a-R3b in the instant claims are selected from hydrogen, hydroxyl, and 1-4C-alkoxy. An analogous species is exemplified in table 1, page 6, line 8, where in R2b is ethoxy.

Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)

One having ordinary skill in the art guided by the exemplified compounds of table 1, page 6, and the species at line 8 of WO 98/42707 would be motivated to modify the homologous prior art compound where in substituent being ethoxy to obtain the instant compound where in the substituent being propoxy.

4. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-67 are rejected under 103(a) as being unpatentable over Senn-Bilfinger et al. WO 98/42707, on page 6, table 1, line 7 in view of Senn-Bilfinger et al. WO 98/42707, on page 6, table 1, line 12.

Determination of the scope and content of the prior art (MPEP §2141.01)

Senn-Bilfinger et al. WO 98/42707 disclosed compounds in table 1, page 6, which have the same structural core as the instant claims.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claims and the prior art compounds is that the prior art on page 6, table 1, and line 7 exemplified where in R2b being methoxy and R3a being hydrogen instead of the R3a being hydroxyl in the instant claims. The WO 98/42707, on page 6, table 1, and line 12 teaches alternatively R3a being hydroxyl.

Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)

One having ordinary skill in the art guided by the exemplified compounds of table 1, page, 6, line 7 of WO 98/42707 in view of line 12 would be motivated to modify the compound of prior art to arrive at the compound of the instant claims.

5. Claim Rejections - Obvious Double Patenting

Claims 1-68 are rejected under the judicially created doctrine obviousness-type double patenting as being unpatentable over the claims 2-7 of the US 6,436,953 or the claims 1-2 of US 6,696,460. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because the current invention embraces the invention claimed in the above patent.

Determination of the scope and content of the prior art (MPEP §2141.01)

Senn-Bilfinger et al. US 6,436,953 or US 6,696,460 claimed compounds which have the same structural core as the instant claims.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claims and the issued claims is that the instant claims have two of R2a, R2b, R3a, R3b being hydrogen, the remaining two is selected from hydroxyl, methoxy, propoxy, isopropoxy, and methoxy-propoxy instead of the R2a-R3b being hydroxyl, methoxy, ethoxy, isopropoxy, and methoxy-propoxy.

Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)

The instant claims are compounds with substituent combination in a more limited manner with the inclusion of the one methyl addition moiety propoxy over the ethoxy which are fully taught by the issued claims interpreted in view of the specification, see US 6,436,953, page 5, table 1, line 10.

This is provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been issued.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 168 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130 (b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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NILOOFAR RAHMANI

10/31/2005

NR


CELIA CHANG

PRIMARY EXAMINER

GROUP 1625